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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,960	05/29/2001	Neil D. Scancarella	Rev 01-6	7403

26807 7590 07/26/2006

JULIE BLACKBURN  
REVLON CONSUMER PRODUCTS CORPORATION  
237 PARK AVENUE  
NEW YORK, NY 10017

EXAMINER

KIM, VICKIE Y

ART UNIT PAPER NUMBER

1618

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/866,960	<b>Applicant(s)</b> SCANCARELLA ET AL.	
	<b>Examiner</b> Vickie Kim	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***RCE acknowledged***

A request for continued examination(RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/23/06 has been entered.

### ***Status of Application***

1. Acknowledgement is made of amendment filed 5/23/06. The claims 1-20 are pending and presented for the examination.

### ***Response to Arguments***

2. Applicant's arguments filed 5/23/06 have been fully considered but they are not persuasive. In response to applicant's argument(see remark at page 13) that the focus of patentability for US049(Vatter)'s product is the cosmetic composition containing the elastomer combination, a solvent, and optionally skin conditional agent where Vatter lists film forming agent and coloring agent as optional ingredients.

This examiner's position is that the claims are broadly drafted where the scope of the claims is encompassed by the teaching of Vatter's patent. All the critical elements required by the instant claims are well taught in the cited reference and thus, the claimed subject matter is not patentably distinct over the prior art of the record.

Art Unit: 1618

Elements required by claims are well taught by the Vatter's patent(US049). And the final product including optional ingredients(additives) is easily manufactured by one of ordinary skill in the art with the methodologies suggested by Vatter's to maximize extra benefits by adding said additives. The instant claims which are drawn to a composition comprising film forming agent(e.g. silicone resin + a silicone/acrylate copolymer or a vinyl/silicone copolymer; an organic pigment and a volatile silicone oil in oil phase, are well taught by the cited patent. And thus, the claims are not patentably distinct over the prior art of the record.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited. Further, they do not show how the amendments avoid such references. Applicant's arguments fail to define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Mcdermott's and Shah's references support the examiner's position where it is routinely mix more than one film forming agent to add benefits. Thus, the claimed invention utilizing more than one film forming agent is not novel over Vatter's patented product.

Thus, the claims are maintained as rejected.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vatter et al(US6696049 ) alone, or if necessary, in view of Mcdermott's(6248336) and Shah(WO00/47168).

Art Unit: 1618

The claims are drawn to a water and oil emulsion composition comprising at least one silicone resin film forming polymer, at least one silicone/acrylate copolymer or a vinyl/silicone copolymer or mixture thereof, at least one organic pigment wherein water is in an amount of 0.1-95% and oil is in an amount of 0.1-99% by weight.

Vatter's patented composition used for skin care products(e.g. eye make-up products such as eye shadow) comprising at least one silicone resin film forming polymer and silicone-acrylate type copolymers such as SA70, see col. 12, lines 38-48. The colorants comprising inorganic or organic pigments are taught at col. 17, lines 10-45. Furthermore, US'049(hereinafter) teaches water (0-95%, see col. 10, lines 45-47) and oils including linear volatile silicone oils(cols. 8, lines 41-58; col.10, lines 40). Viscosity agent, volatile solvent, non-volatile oil, a dry particulate matter, etc are taught by the cited reference throughout the patented disclosure.

As mentioned in previous office action, the variations are considered to be minor and the modifications are routinely practiced(see Cosmetics, Science and Technology: color in Cosmetics, Chapter 44(1957) by Samuel Zuckerman, previously provided). Thus, it is the examiner's position that one having ordinary skill in the art would readily recognize that how to modify the formulation utilizing the ingredients taught and suggested by Vatter's to make the final cosmetic composition to satisfy user's need with better appearance and quality when Vatter's reference is taken alone or if necessary, taken in view of Shah and Mcdermott (their teachings are mentioned in previous office action) because it is well within the skill of those having ordinary skill in the art to adjust and employee different ingredients to arrive at a desired quality.

Although all the elements are not specifically included in any examples, one of ordinary skill in the art would have been readily understand and modify with proper substitution as suggested by Vatter's teaching. Thus, all the critical elements which are well taught by the cited reference and thus, the claimed subject matter is obvious variation and not patentably distinct over the prior art of the record.

### **Conclusion**

1. No claim is allowed.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579.

The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

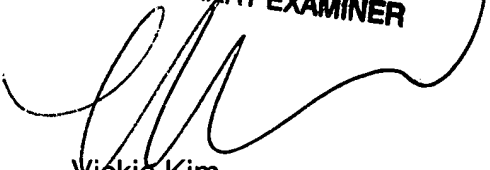
Application/Control Number: 09/866,960

Page 5

Art Unit: 1618

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**VICKIE KIM  
PRIMARY EXAMINER**



Vickie Kim  
July 24, 2006  
Art unit 1618